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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Jonathan P. KRUEGER

Application No. 09/639,385

Filed: August 14, 2000

For: APPARATUS, METHODS, AND
COMPUTER PROGRAM PRODUCTS
FOR FILTERING INFORMATION

Attorney Docket No. SUNMP328

Group Art Unit: 2131

Date: September 6, 2005

RECEIVED

SEP 14 2005

Technology Center 2100

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450 on September 6, 2005.

Signed: _____

Kay Harlow

REQUEST FOR RECONSIDERATION OF DISMISSAL OF PETITION TO
WITHDRAW HOLDING OF ABANDONMENT
Under 37 CFR § 1.181

Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

The undersigned received a communication dated August 15, 2005, in which a Petition to withdraw the holding of abandonment under 37 CFR §1.181 was filed on February 23, 2005. The Petition was DISMISSED in the communication dated August 15, 2005. A discussion was had with Mr. Brian L. Johnson of the Special Programs Examiner, Technology Center 2100, regarding the dismissal on September 6, 2005. This request for reconsideration is being filed within two months of the decision mailed on August 15, 2005.

The Office points to two separate reasons for the dismissal.

(I) The first reason is related to MPEP 711.03(c), in which the Office notes that the undersigned failed to provide evidence of non-receipt of the Office Action mailed on November 19, 2003.

This section points to items 1-4. For item 1, the undersigned did indicate that the Office Action was not received in the Petition of February 23, 2005. For items 2-3, *prima-facie* evidence that the undersigned did not receive the Office Action of November 19, 2003, is set in the fact that the USPTO mailed the Office Action to the prior attorney of record, and not to the undersigned. Consequently, it is not necessary to prove that we did not receive the Office Action, as from the USPTO's records themselves, it is evident that the Office Action was NOT mailed to the undersigned.

(II) The second reason is that the filing of the statement under 3.73(b) and Power of Attorney (filed on April 8, 2003, by hand delivery as evidenced by the RECEIVED stamp, TC 2100), was not filed in the instant application.

The Office cites to MPEP § 403, 502.02, and 601.03, to support refusal of the change of address. In the conversation with the Office on September 6, 2005, Mr. Johnson indicated that the change of address was improperly filed, because the change of address did not identify a "single" application. As evidenced by the documents filed with the February 23, 2005 petition, the undersigned listed seven (7) applications, five (5) of which were in Technology Center 2100. These applications, of which the instance application is one, were identified on the coversheet, and on Appendix A. In the April 8, 2003 filing, the "change of address" document itself identified Customer Number 25,920. The change of address document pointed to the applications listed on Appendix A.

According to MPEP § 601.03, "*Unless the correspondence address is designated as the address associated with a Customer Number, a separate notification must be filed in each application...*" This section of the MPEP is dated August 2001, and this section was copied from an MPEP book with a latest revision of February 2003 (copies enclosed, A-1 to A-6). The Office also points to MPEP § 403. As noted in § 403, a number of forms can be used to change the address. The address can be changed under form (E), which notes that "the 'Correspondence Address Indication From' (PTO/SB/121) to change the correspondence address of a list of applications or patents to the address associated with a Customer Number." (*emphasis added*) (copies of the PTO form, and MPEP pages enclosed, A-1 to A-6). *The PTO website (as of September 6, 2005) notes that form PTO/SB/121 was deleted as of July 2003. The change of address was filed on April 8, 2003.*

CONCLUSION:

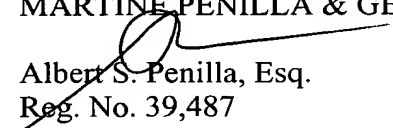
Under Section I above, it is evident that the Applicant need not provide further proof of non-receipt of the Office Action of November 19, 2003, as the USPTO did not mail the Office Action to the undersigned's office.

Under Section II above, the MPEP allowed the change of address for a "*list*" of applications, since the list WAS associated with a Customer Number. Separate filings for each application number was not required, as the change of address form cited a Customer Number.

The undersigned respectfully submits that it is improper to dismiss this Petition under the reasons outlined in the dismissal communication of August 15, 2005. **Accordingly, the undersigned respectfully requests the Office to grant the Petition dated February 23, 2005, and forward the undersigned a new Office Action to replace the action of November 19, 2003.**

If the Examiner has any questions concerning the present paper, the Examiner is kindly requested to contact the undersigned at (408) 749-6903. If any other fees are due in connection with filing this amendment, the Commissioner is also authorized to charge Deposit Account No. 50-0805 (Order No. SUNMP328). A duplicate copy of the transmittal is enclosed for this purpose.

Respectfully submitted,
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Manual of PATENT EXAMINING PROCEDURE

Original Eighth Edition, August 2001
Latest Revision February 2003



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U.S. DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

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previously established on the filing of the application, or changed per 37 CFR 1.63(a)(1), even if the application was filed by a company that is only a partial assignee. The expression "party that will be the assignee," rather than assignee, is used in that until a declaration is submitted, inventors have only been identified, and any attempted assignment, or partial assignment, cannot operate for Office purposes until the declaration is supplied. Hence, if the application transmittal letter indicates that the application is being filed on behalf of XYZ company, with an assignment to be filed later, XYZ company would be allowed to change the correspondence address without resort to 37 CFR 3.73(b) until an executed oath or declaration is filed, and with resort to 37 CFR 3.73(b) after the oath or declaration is filed.

Where a correspondence address was set forth or changed pursuant to 37 CFR 1.33(a)(1) (prior to the filing of a 37 CFR 1.63 oath or declaration), that correspondence address remains in effect upon filing of a 37 CFR 1.63 declaration and can then only be changed pursuant to 37 CFR 1.33(a)(2).

37 CFR 1.33 states that when an attorney has been duly appointed to prosecute an application correspondence will be held with the attorney unless some other correspondence address has been given. Double correspondence with an applicant and his or her attorney, or with two representatives, will not be undertaken. See MPEP § 403.01, § 403.02, and § 714.01(d).

If double correspondence is attempted, form paragraph 4.01 should be included in the next Office action.

¶ 4.01 Dual Correspondence

Applicant has appointed an attorney or agent to conduct all business before the Patent and Trademark Office. Double correspondence with an applicant and applicant's attorney or agent will not be undertaken. Accordingly, applicant is required to conduct all future correspondence with this Office through the attorney or agent of record. See 37 CFR 1.33.

Examiner Note:

1. The first time a reply is received directly from applicant, include this paragraph in the Office action and send a copy of the action to the applicant. See MPEP §§ 403 and 714.01.
2. Should applicant file additional replies, do not send copies of subsequent Office actions to the applicant.
3. Status letters from the applicant may be acknowledged in isolated instances.

In a joint application with no attorney or agent, the applicant whose name first appears in the papers

receives the correspondence, unless other instructions are given. All applicants must sign the replies. See MPEP § 714.01(a). If the assignee of the entire interest is prosecuting the application (MPEP § 402.07), the assignee may specify a correspondence address.

37 CFR 1.33(c) relates to which address communications for the patent owner will be sent in reexamination proceedings. See also MPEP § 2224.

Powers of attorney to firms are not recognized by the U.S. Patent and Trademark Office. See MPEP § 204. However, the firm's address will be considered to be the correspondence address. The address should appear as follows:

John Doe (inventor)
In care of Able, Baker, and Charlie (firm)
1234 Jefferson Davis Highway
Arlington, Virginia 22202

See MPEP § 601.03 for change of correspondence address.

See MPEP § 201.06(c) regarding change of correspondence address in continuation or divisional applications filed under 37 CFR 1.53(b).

CUSTOMER NUMBER PRACTICE

A Customer Number (previously a "Payor Number") may be used to:

(A) designate the correspondence address of a patent application by a Customer Number such that the correspondence address for the patent application would be the address associated with the Customer Number;

(B) designate the fee address (37 CFR 1.363) of a patent by a Customer Number such that the fee address for the patent would be the address associated with the Customer Number; and

(C) submit a list of practitioners by Customer Number such that an applicant may in a Power of Attorney appoint those practitioners associated with the Customer Number.

Thus, a Customer Number may be used to designate the address associated with the Customer Number as the correspondence address of an application (or patent) or the fee address of a patent, and may also be used to submit a power of attorney in the application (or patent) to the registered practitioners associated with the Customer Number.

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Applicant may use either the same or different customer number(s) for the correspondence address, the fee address and/or a list of practitioners. The customer number associated with the correspondence address is the customer number used to obtain access to the Patent Application Information Retrieval (PAIR) system at <http://pair.uspto.gov>. See MPEP § 1730 for additional information regarding PAIR.

The following forms are suggested for use with the Customer Number practice:

(A) the "Request for Customer Number" (PTO/SB/125) to request a Customer Number;

(B) the "Request for Customer Number Data Change" (PTO/SB/124) to request a change in the data (address or list of practitioners) associated with an existing Customer Number;

(C) the "Change of Correspondence Address, Application" (PTO/SB/122) to change the correspondence address of an individual application to the address associated with a Customer Number;

(D) the "Change of Correspondence Address, Patent" (PTO/SB/123) to change the correspondence address of an individual patent to the address associated with a Customer Number; and

X (E) the "Correspondence Address Indication Form" (PTO/SB/121) to change the correspondence address of a list of applications or patents to the address associated with a Customer Number.

The Office will also accept requests submitted electronically via a computer-readable diskette to:

(A) change the correspondence address of a list of applications or patents or the fee address for a list of patents to the address associated with a Customer Number; and

(B) submit a power of attorney in a list of applications or patents to the registered practitioners associated with the Customer Number.

Such electronic requests must be submitted in the manner set forth in the Notice entitled "Extension of the Payor Number Practice (through "Customer Numbers") to Matters Involving Pending Patent Applications," published in the *Federal Register* at 61 FR 54622, 54623-24 (October 21, 1996), and in the *Official Gazette* at 1191 O. G. 187, 188-89 (October 29, 1996).

The Customer Number practice does not affect the current practice of permitting a patentee to provide a "fee address" for the receipt of maintenance fee correspondence. A patentee will be able to designate a "fee address" for the receipt of maintenance fee correspondence, and a different address for the receipt of all other correspondence. The designation of a "fee address" by reference to a Customer Number will not affect or be affected by the designation of a correspondence address by reference to another Customer Number, in that the Office will send maintenance fee correspondence to the address associated with the Customer Number designated as the "fee address" and will send all other correspondence to the address associated with the Customer Number designated as the correspondence address.

The association of a list of practitioners with a Customer Number will permit an applicant to appoint all of the practitioners associated with the Customer Number merely by reference to the Customer Number in the Power of Attorney (i.e., without individually listing the practitioners in the Power of Attorney). The addition and/or deletion of a practitioner from the list of practitioners associated with a Customer Number will result in the addition or deletion of such practitioner from the list of persons authorized to represent any applicant who appointed all of the practitioners associated with such Customer Number. This will avoid the necessity for the filing of additional papers in each patent application affected by a change in the practitioners of the law firm prosecuting the application. The appointment of practitioners associated with a Customer Number will be optional, in that any applicant may continue to individually name those practitioners to represent the applicant in a patent application.

The Customer Number practice does not affect the prohibition against, and does not amount to, an appointment of a law firm (rather than specified practitioners). The Office prohibits an appointment of a specified law firm because the Office cannot ascertain from its records whether a particular practitioner submitting a paper to the Office is associated with the law firm specified in an appointment. The Office will permit an appointment of all of the practitioners associated with a specified Customer Number because the Office can ascertain from its records for the specified

Customer Number whether a particular practitioner is associated with that Customer Number.

As the Office will not recognize more than one correspondence address (37 CFR 1.33(a)), any inconsistencies between the correspondence address resulting from a Customer Number being provided in an application for the correspondence address and any other correspondence address provided in that application would be resolved in favor of the address of the Customer Number. Due to the prohibition against dual correspondence in an application (37 CFR 1.33(a)), an applicant will be permitted to provide only a single number at a time as the Customer Number for the correspondence address.

Where an applicant appoints all of the practitioners associated with a Customer Number as well as a list of individually named practitioners, such action would be treated as only an appointment of all of the practitioners associated with a Customer Number due to the potential for confusion and data entry errors in entering registration numbers from plural sources.

Although Customer Numbers are designed to designate both a correspondence address and to associate one or more patent attorneys or agents with an application, one Customer Number may be used for the correspondence address, and another Customer Number may be used for the power of attorney.

Applicants are strongly cautioned not to attempt to appoint more than one Customer Number for a particular purpose (e.g., correspondence address) in a single communication, as such action will **not** have a cumulative effect.

The Office has created a box designation for correspondence related to a Customer Number ("Box CN"), and all correspondence related to a Customer Number (e.g., requests for a Customer Number) should be addressed to this box designation.

The following persons are authorized to change the information associated with an established Customer Number: (1) a registered practitioner associated with the Customer Number; and (2) the person who requested the Customer Number (signed the Request for Customer Number, Form PTO/SB/125).

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Please type a plus sign (+) inside this box ☐

Approved for use through 10/31/2002. OMB 0651-0035
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

CORRESPONDENCE ADDRESS INDICATION FORM

Address to:

Assistant Commissioner for Patents
Box CN
Washington, DC 20231

Please recognize the following address as the correspondence address:

☐ Customer Number
OR
Type Customer Number here

Place Customer Number
Bar Code Label here

☐ Request for Customer Number (PTO/SB/125) submitted herewith.

In the following listed application(s) or patent(s):

Patent Number (if appropriate)	Application Number	Patent Date (if appropriate)	U.S. Filing Date
			<p>RECEIVED SEP 14 2005 Technology Center 2100</p>

Typed or Printed Name		<p>(check one)</p> <p><input type="checkbox"/> Applicant or Patentee</p> <p><input type="checkbox"/> Assignee of record of the entire Interest. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> Attorney or Agent of record</p> <p>(Reg. No.)</p>
Signature		
Date		
Address of signer:		

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box CN, Washington, DC 20231.

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the inventors), that correspondence address remains in effect upon filing of an executed oath or declaration under 37 CFR 1.63 and can only be subsequently changed pursuant to 37 CFR 1.33(a)(2). Under 37 CFR 1.33(a)(2), where an executed oath or declaration under 37 CFR 1.63 has been filed by any of the inventors, the correspondence address may be changed by (A) a registered attorney or agent of record appointed in compliance with 37 CFR 1.34(b), (B) an assignee as provided for under 37 CFR 3.73(b), or (C) all of the applicants (37 CFR 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with 37 CFR 3.71. See 37 CFR 1.33(a)(2).

Where an attorney or agent of record (or applicant, if he or she is prosecuting the application *pro se*) changes his or her correspondence address, he or she is responsible for promptly notifying the U.S. Patent and Trademark Office of the new correspondence address (including ZIP Code). The notification should also include his or her telephone number. A change of correspondence address may not be signed by an attorney or agent not of record (see MPEP § 405).

Unless the correspondence address is designated as the address associated with a Customer Number, a separate notification must be filed in each application for which a person is intended to receive communications from the Office. See MPEP § 403 for Customer Number Practice. In those instances where a change in the correspondence address of a registered attorney or agent is necessary in a plurality of applications, the notification filed in each application may be a reproduction of a properly executed, original notification. The original notice may either be sent to the Office of Enrollment and Discipline as notification to the Attorney's Roster of the change of address, or may be retained by applicant. See MPEP § 502.02.

Special care should be taken in continuation or divisional applications to ensure that any change of correspondence address in a prior application is reflected in the continuation or divisional application. For example, where a copy of the oath or declaration from the prior application is submitted for a continuation or divisional application filed under 37 CFR 1.53(b) and the copy of the oath or declaration from the prior application designates an old correspondence address, the Office may not recognize, in

the continuation or divisional application, the change of correspondence address made during the prosecution of the prior application. Applicant is required to identify the change of correspondence address in the continuation or divisional application to ensure that communications from the Office are mailed to the current correspondence address. 37 CFR 1.63(d)(4).

See MPEP § 711.03(c) for treatment of petitions to revive applications abandoned as a consequence of failure to timely receive an Office action addressed to the old correspondence address.

The required notification of change of correspondence address need take no particular form. However, it should be provided in a manner calling attention to the fact that a change of address is being made. Thus, the mere inclusion, in a paper being filed for another purpose, of an address which is different from the previously provided correspondence address, without mention of the fact that an address change is being made would not ordinarily be recognized or deemed as instructions to change the correspondence address on the file record.

The obligation (see 37 CFR 10.11) of a registered attorney or agent to notify the Attorney's Roster by letter of any change of his or her address for entry on the register is separate from the obligation to file a notice of change of address filed in individual applications. See MPEP § 402.

601.04 National Stage Requirements of the United States as a Designated Office

See MPEP Chapter 1800, especially MPEP § 1893.01 for requirements for entry into the national stage before the Designated Office or Elected Office under the Patent Cooperation Treaty (PCT).

601.05 Bibliographic Information Application Data Sheet (ADS)

37 CFR 1.76. Application Data Sheet

(a) *Application data sheet.* An application data sheet is a sheet or sheets that may be voluntarily submitted in either provisional or nonprovisional applications, which contains bibliographic data, arranged in a format specified by the Office. If an application data sheet is provided, the application data sheet is part of the provisional or nonprovisional application for which it has been submitted.

(b) *Bibliographic data.* Bibliographic data as used in paragraph (a) of this section includes: